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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/873,361 | 06/05/2001 | Toshio Yoshida | 826.1728 | 5163 |

21171 7590 11/17/2006

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| EXAMINER |
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AKINTOLA, OLABODE

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| ART UNIT | PAPER NUMBER |
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3691

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/873,361

Applicant(s)

YOSHIDA ET AL.

Examiner

Olabode Akintola

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election without traverse of Group I (claims 1-72) in the reply filed on 10/19/2006 is acknowledged.

Claim Rejections - 35 USC § 112.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-72 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claims 4, 28 and 52 recites the limitation "the transaction partner" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-5, 9, 12, 16-20, 23-26, 28-29, 33, 36, 40-44, 47-50, 52-53, 57, 60, 64-68, and 71-72 are rejected under 35 U.S.C. 102(e) as being anticipated by Jalili (USPN 6088683).

Re claims 1, 25 and 49: Jalili teaches an online settlement system for settling payment of a transaction online (Abstract), comprising: a transaction content storage unit storing a transaction content of a user (col. 2, lines 28-39); an unsettled payment list display unit presenting transaction contents, the price of which is not paid, out of the transaction contents stored in the transaction content storage unit at a request from the user (col. 2, lines 28-39); and a payment unit enabling the user to pay a price of a transaction content to be settled by the user using an account handling institute (col. 2, lines 40-67).

Re claims 2, 26 and 50: Jalili teaches the step wherein said transaction content storage unit receives online a content of a transaction conducted online by a user and stores the content (col. 2, lines 28-39).

Re claims 4, 28 and 52: Jalili does not explicitly teach a unit notifying a user of a payment request if a transaction content of a user is received from the transaction partner (col. 3, lines 7-11).

Re claims 5, 29 and 53: Jalili teaches the step wherein the account handling institute can settle a

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payment online (col. 2, lines 63-65).

Re claims 9, 33 and 57: Jalili teaches the step a transaction content list display unit displaying a list of transaction contents conducted with a transaction partner at a request from the transaction partner of a user (col. 2, lines 36-37).

Re claims 12, 36 and 60: Jalili teaches the step a notification unit notifying a transaction partner of payment of a price of a transaction, which is settled by the user (col. 3, lines 1-5).

Re claims 16, 40 and 64: Jalili teaches the step wherein a payment time limit of each transaction is set in said transaction content storage unit and the transaction content of each transaction is deleted when the payment time limit is expired (col. 2, lines 37-39).

Re claims 17, 41 and 65: Jalili teaches the step wherein prior to deletion of the transaction content, the deletion of the transaction content is reported to the transaction partner of the transaction content (col. 3, lines 1-6).

Re claims 18, 42 and 66: Jalili teaches the step wherein if there are a plurality of transaction contents, the plurality of transaction contents are grouped and payment of the plurality of transaction contents is settled at one time (col. 2, lines 36-38).

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Re claim 19, 43 and 67: Jalili teaches the step wherein if an account balance of an account handling institute is not sufficient to settle payment of all the grouped transaction contents, the payment of the entire grouped transaction contents is stopped (col. 2, lines 12-13).

Re claims 20, 44 and 68: Jalili teaches the step wherein the transaction contents stored in said transaction content storage unit are generated and stored when the user applies for a transaction, and both display of a list of transaction contents, the price payment of which are not settled, and payment of the prices are made after the user applies for the transaction (col. 2, lines 35-39).

Re claims 23-24, 47-48 and 71-72: Jalili teaches a transaction content detailed information display unit displaying detailed information about transaction contents displayed by said unsettled payment list display unit; said transaction content detailed information display unit further comprising a transaction target information display unit displaying information about a transaction target (col. 2, lines 35-39).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 22, 46 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jalili.

Re claims 22, 46 and 70: Jalili does not explicitly teach the step wherein if the price is paid, account balance of an account handling institute used by the user is presented to the user.

However, Jalili teaches credit limit (col.2, line12). Official notice is hereby taken that it is old and well known in the art to display account balance to users after transaction settlement. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jalili to include this step in order to ensure that the user does not exceed his credit limit.

Claims 3, 27 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jalili in view of Kumar et al (USPAP 20010023414).

Re claims 3, 27 and 51: Jalili does not explicitly teach the step wherein said transaction content storage unit receives online a content of a transaction conducted offline by a user from a transaction partner of the user and stores the content. Kumar teaches the step wherein said transaction content storage unit receives online a content of a transaction conducted offline by a

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user from a transaction partner of the user and stores the content (section 0228). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jalili to include this step as taught by Kumar. One would have been motivated to do this in order to afford the user the opportunity to settle offline transaction via the web.

Re claims 6-8, 10, 30-32, 34, 54-56 and 58: Jalili does not explicitly teach a deletion unit deleting a settled item from a transaction content stored in said transaction content storage unit; wherein said deletion unit stores a settled item in a settled transaction content storage unit; a user payment history display unit displaying user's past payment histories at a request from the user. Kumar teaches a deletion unit deleting a settled item from a transaction content stored in said transaction content storage unit; wherein said deletion unit stores a settled item in a settled transaction content storage unit; a user payment history display unit displaying user's past payment histories at a request from the user (sections 0234 and 0240). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jalili to include these steps as taught by Kumar. One would have been motivated to do this in order to place the settled item in the bills history list.

Claims 11, 35 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jalili in view of Yun et al (USPAP 20020069122).

Re claims 11, 35 and 59: Jalili does not explicitly teach an account handling institute recommendation unit recommending an appropriate account handling institute to be used to the

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user if there are a plurality of the account handling institutes. Yun teaches an account handling institute recommendation unit recommending an appropriate account handling institute to be used to the user if there are a plurality of the account handling institutes (section 0031 and 0034). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jalili to include these steps as taught by Yun. One would have been motivated to do this in order to assist the user in making the most appropriate or lest expensive institute.

Claims 13-15, 37-39 and 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jalili in view of Furphy et al (USPN 6882983).

Re claims 13-15, 37-39 and 61-63: Jalili does not explicitly teach a warning unit setting a payment time limit to each transaction and warning the user against the payment when the payment time limit of each transaction comes a prescribed number of days before; wherein said warning unit warns a user against payment when the user is logged in this online settlement system; wherein said warning unit warns a user against payment by electronic mail. Furphy teaches a warning unit setting a payment time limit to each transaction and warning the user against the payment when the payment time limit of each transaction comes a prescribed number of days before; wherein said warning unit warns a user against payment when the user is logged in this online settlement system; wherein said warning unit warns a user against payment by electronic mail (col. 13, lines 39-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jalili to include these steps as taught by Furphy. One would have been motivated to do this in order to alert the user about the pending invoice before

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it becomes due.

Claims 21, 45 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jalili in view of Guheen et al (USPN 6473794).

Re claim 21, 45 and 69: Jalili does not explicitly teach an advertisement related to the transaction contents is presented to the user together with the list. Guheen teaches an advertisement related to the transaction contents is presented to the user together with the list (col. 192, lines 41-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jalili to include this step as taught by Guheen. One would have been motivated to do this in order to generate advertisement income from advertisers.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629.

The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA



HANI M. KAZIMI
PRIMARY EXAMINER